

REMARKS

Claims 1-27 are pending in this application and are again believed to be distinguishable over the cited prior art, including Katz et al., U.S. Patent No. 5,926,624 and Kanota et al., U.S. Patent No. 5,991,500. As a result, no claim has been amended herein.

Turning now to the substance of the final Office Action, claims 1, 6, 8-9, 11-13 and 15-16 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 in view of Kanota et al., U.S. Patent No. 5,991,500 for reasons stated on pages 4-6 of the final Office Action (Paper No. 20071210). The rationale is repeated verbatim from the previous Office Action. Specifically, in support of the rejection of Applicants' base claims 1, 8 and 16, the Examiner asserts that Katz '624, as a primary reference, discloses,

"at least one original content, a remake content based on at least one original content; (Katz, Col. 6 Lines 47-50, selected preview clips) and copying right information corresponding to the remake content, wherein the copyright information includes original copyright information which, when processed by a processor, is used to identify at least a copyright owner of the original content and remake copyright information (Katz, Col. 7 Lines 10-16).

The Examiner has now admitted that Katz '624 does **not** disclose,

"remake copyright information which, when processed by the processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content."

The Examiner has relied upon Kanota et al., U.S. Patent No. 5,991,500, at column 2, lines 28-45, for allegedly disclosing the missing features, that is, the "remake copyright information which, when processed by the processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content."

As previously discussed, the Examiner's assertions of the alleged teachings based on katz '624 Kanota '500 are incorrect and should be withdrawn for following reasons.

A. The Examiner failed to establish a *prima facie* case of obviousness of Appellants' independent claims 1, 8 and 16 because there is no factual evidence to support such a conclusion of obviousness.

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of establishing a *prima facie* of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 26 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetker*, 977 F.2d 1443, 1445 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the Appellants. *Rijckaert*, 9 F.3d at 1532, 26 USPQ2d at 1956. When the reference(s) cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and must be overturned. *In re Fine*, 873 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Obviousness under 35 U.S.C. §103 is a legal conclusion based on factual evidence, not a factual determination. *Graham v. Deere*, 383 U.S. 1, 148 USPQ 459. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 873 F.2d at 1074, 5 USPQ2d at 1598. Determination of obviousness must be based on facts, and not on unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Any deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. Id.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations. In addition, there must be some reasons to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. Any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". See In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, the Examiner has **not** met the initial burden of producing factual evidence to establish a *prima facie* case of obviousness. Specifically, the Examiner has ignored to treat the claim invention as a whole, incorrectly characterized teachings of the cited prior art relative to limitations of Appellants' base claims 1, 8 and 16, and failed to provide any reason for incorporating Kanota '500 into the digital information library system of Katz '624 in the manner to arrive at Appellants' claimed invention.

As previously discussed, base claims 1, 8 and 16 clearly define a recording medium

which comprises two types of information: (1) remake content based on at least one original content, as shown in FIG. 1; and (2) copyright information, as shown in FIG. 1, including both (a) original copyright information which, when processed by an apparatus, causes the apparatus to identify at least a copyright owner of the original content, and (b) remake copyright information which, when processed by an apparatus, causes the apparatus to identify at least a maker of the remake content, as shown in FIG. 4. This way the copyright of the original content can be advantageously protected, while the personal use rights of an individual user on the original content can be guaranteed.

In contrast to Applicants' base claims 1, 8 and 16, Katz '624, as primary reference, only discloses a computer network based digital information library system, as shown in FIG. 2, in which a client computer system 214 or a mobile playback system 212 at a client site 210 can access a library server 260 for an indexed collection of digital information obtained from different sources, such as books, daily news, entertainment feeds, conferences and educational sources, via a distribution network 240 at a library site 250.

At the library site 250, an authoring system 280 is used to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260. Such an authoring system 280 can also be used to partition digital information content into segments, which can be identified, searched, and skipped over if desired. As shown in FIG. 3, the authoring system 280 contains a preview generator 232 which generates preview clips 324 for providing short pre-generated portions of digital information content used to give a consumer a sense of the content of a particular digital information file. As further described on column 6, lines 42-68 of Katz '624,

"[T]he raw digital information content 310 is also fed to template header generator 312. Each digital information file maintained by the library server 260 includes other descriptive information used to identify the file's content and to provide information used to process the digital information within the file. **Each digital information file includes a template header**, a descrambling map, selected preview clips, and the digital information programming itself. In the preferred embodiment, the template header comprises a number of attributes corresponding to the digital information in the file. For example, the digital information may be audio information generated from the content of a book or other published work. In this example, the audio file template header contains attributes including: 1) the title of a book, volume, or medium from which the digital information content originated, 2) the legal copyright associated with the digital information content, 3) audible title(s) of the content, 4) a table of contents of the content, and 5) playback settings for appropriately playing or rendering the digital information. The table of contents contains content navigation information

including but not limited to: the number of chapters, the length of the program, and information indicative of the relevant content sections. The table of contents is generated with input from authoring system operator 305 or automatically by analysis of digital information content 310."

As described by Katz '500, such an authoring system 280 is only used at a library site 250 to edit, index, compress, scramble, segment, and catalog digital information content into digital information files for storage on the library server 260.

At a client site 214, a computer system, typically a PC, as shown in FIG. 2, is used to allow a user to browse, preview, select, purchase, and take delivery of digital information content from digital information library server 260, via a network 240.

Upon request, digital information can be transferred from the library site 250 to the client computer 214 (at a client site); however, such digital information does **not** include any remake copyright information as mistakenly believed by the Examiner.

Nonetheless, the Examiner cites column 7, lines 10-16 of Katz '624 for allegedly disclosing the use of "remake copyright information". However, the cited column 7, lines 10-16 of Katz '624 simply refers to the digital information files that have been edited, indexed, compressed, scrambled, segmented, and cataloged by the authoring system 280 at a library site 250 for downloading to the requesting client computer 214 at the client site 210.

Again, there is **no** disclosure or suggestion anywhere in Katz '624 of Applicants' claimed "remake copyright information that is used **"to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content"** as expressly defined in Applicants' base claims 1, 8 and 16.

As a secondary reference, Kanota '500 does **not** disclose or suggest this feature as alleged by the Examiner. Rather, Kanota '500 only discloses a serial copy management system (SCMS) for a video signal, as shown in FIG. 1, in which the copying of a video signal is controlled so as to permit a consumer to make one copy directly from a video signal (whether that video signal is broadcasted or reproduced from a video tape or video disk), but a copy of the copy (that is a re-recording of the copy) may be prohibited. As described on column 2, lines 1-14 of Kanota '500,

"[F]or example, a first generation [copying] may be permitted but a second generation [copying] may be prohibited. As another example, first and second generations may be permitted but a third generation may not (i.e. a recording and a re-recording may be permitted but a re-re-recording may be prohibited). In the

foregoing copy protection schemes, if a video signal is permitted to be copied, a copy of the copied signal may be made and successive generations likewise may be made. But if a video signal is prohibited from being copied, even a single generation copy cannot be made."

In addition, as further described on column 2, lines 28-45 of Kanota '500, copy protection for a video signal is accomplished by superposing in a single line interval of a single field (or different line intervals in different fields) of the video signal which does not contain useful picture information, as shown in FIG. 1, both a copyright information signal S1 and a copy generation signal S2. In addition, a copy generation signal detector is used to selectively decrement the number of successive generations of copies indicated by the copy generation signal, thereby controlling subsequent re-recording of the video signal.

According to Kanota '500, the copyright information signal S1 is used to **indicate whether the viewable picture that may be produced from the video signal is subject to copyright**. In contrast, the copy generation signal S2 is used to **indicate the number of successive generations of copies that can be made from the video signal**.

Both the copyright information signal S1 and the copy generation signal S2 can be expressed in terms of single bit signals or plural bit signals. For example, as shown in TABLE 1, in column 7, lines 45-50 of Kanota '500, **S1** and **S2** can be expressed in terms of "1" and "0" which dictate whether copying is permitted or prohibited. If the copyright information signal S1 is not subject to copyright law, S1 is set to "0", then all copies will be permitted; however, if S1 is set to "1", then copying will only be permitted based on the setting of the copy generation signal S2.

Again, there is **no** disclosure in the cited column 2, lines 28-45 or neither the copyright information signal S1 nor the copy generation signal S2 as disclosed by Kanota '500 corresponds to Applicants' claimed "remake copyright information which, when processed by a processor, causes the processor to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content, as shown in FIG. 4, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in Applicants' base claims 1, 8 and 16.

In fact, neither Katz '624 nor Kanota '500, whether taken individually or in combination, discloses and suggests Applicants' claimed "remake copyright information [used] to identify at

least a maker of the remake content representing a user that is different from the copyright owner of the original content, as defined in Applicants' base claims 1, 8 and 16.

Nevertheless, on pages 2-3 of the final Office Action, the Examiner disagrees with Applicants' analysis of Katz '624 and Kanota '500. Specifically, on page 3 of the final Office Action, the Examiner cites column 2, lines 28-45 of Kanota '500 for allegedly disclosing the use of Applicants' claimed "remake copyright information that is used **"to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content"**.

However, this citation is completely misplaced. The cited column 2, lines 28-45 of Kanota '500 only refers to the copyright information signal S1 and the copy generation signal S2 used for a completely different purpose. Again, according to Kanota '500, the copyright information signal S1 is used to indicate whether the viewable picture that may be produced from the video signal is subject to copyright. In contrast to the copyright information signal S1, the copy generation signal S2 is used to indicate the number of successive generations of copies that can be made from the video signal. However, neither the copyright information signal S1 nor the copy generation signal S2, as disclosed by Kanota '500 corresponds to Applicants' claimed "remake copyright information that is used **"to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content"**.

Separately, on the same page 3 of the final Office Action, the Examiner also asserts that Kanota '500 is cited for disclosing that,

"the copyright information that identifies a copyright owner that is different from the original owner," and

"the new copyright information is embedded into the signal. New copyright information, implies that the information is not the same as the original and is now the new updated information, based on the new owner of the content."

However, the Examiner's assertion is factually incorrect. Specifically, 37 CFR §1.104(c)(2) requires that,

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly

explained and each rejected claim specified."

In the present situation, no where in Kanota '500, and the Examiner has not cited any specific portion of Kanota '500 to support such an assertion. Moreover, in contrast to the Examiner's misunderstanding of Kanota '500, there is absolutely **no** disclosure of any **new** copyright information, nor is there any inference that the new copyright information is based on the new owner of the content. Rather, a copyright information signal S1 is used to indicate whether the viewable picture that may be produced from the video signal is subject to copyright.

- B. The Examiner further erred in making the modification of Katz '624 to incorporate the alleged "remake copyright information [that is used] to identify at least a maker of the remake content representing a user that is different from the copyright owner of the original content" from Kanota '500 in order to arrive at Appellants' independent claims 1, 8 and 16 because the Examiner's proposed modification of Kanota '500 changes the principle of operation of Katz '624.**

Likewise, if the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the prior art reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Even assuming *arguendo* that the digital information library system of Katz '624, as shown in FIG. 2, is to be modified to incorporate the remake copyright information feature as allegedly disclosed by Kanota '500 in order to arrive at Applicants' base claims 1, 8 and 16, such a modification will undoubtedly change the principle of operation of Katz '624, since neither the copyright information signal S1 nor the copy generation signal S2 of Kanota '500 [used to indicate whether the viewable picture that may be produced from a broadcast video signal is subject to copyright, and the number of successive generations of copies that can be made from the broadcast video signal] can be deployed in the digital information library system in which copyright information is already included in a header of teach digital information file.

In view of these reasons and reasons previously discussed, Applicants respectfully request that the rejection of claims 1, 6, 8-9, 11-13 and 15-16 be withdrawn.

Separately, dependent claims 2-5, 7, 19-22 and 26 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 and Kanota et al.,

U.S. Patent No. 5,991,500 and in view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 6-8 of the final Office Action. According to the Examiner, Fuchigami '398, as another secondary reference, is cited for allegedly suggesting the use of copyright information that includes a producer code of an apparatus used in making the remake content (Fuchigami, Col. 5 Lines 46-56, SID). Again, the rejection is improper because, even if Fuchigami '398 is incorporated into the computer network based digital information library and delivery system as disclosed by Katz '624, the proposed incorporation still does **not** arrive at Applicants' claims 2, 3, 4, 5, 7, 19, 20, 21, 22 and 26. This is because Fuchigami '398 only discloses a copyright information embedding system, as shown in FIG. 1, in which copyright information for copyright protection can be embedded into digital audio signal without deterioration of analog audio reproduced. As acknowledged on column 1, lines 44-48 of Fuchigami '398, conventional system used to embed copyright data into digital data has the drawback in that digital-to-analog (D/A) conversion of the digital data into analog audio data would cause reproduced sound quality to be deteriorated or changed uncomfortably. Again, like Katz '624 and Kanota '500, Fuchigami '398 does **not** disclose or suggest Applicants' efforts to reproduce from a recording medium: 1) remake content based on at least one original content, as shown in FIG. 1; and 2) copyright information, as shown in FIG. 1, that has both (a) original copyright information on the original content, and (b) remake copyright information on the remake content, which can ensure copyright protection of the original content, while securing the personal use rights of an individual user on the original content, as generally defined in the base claims. In view of these reasons and reasons previously discussed, Applicants respectfully request that the rejection of claims 2-5, 7, 19-22 and 26 be withdrawn.

Lastly, dependent claims 17-18, 24-25 and 27 stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624 and Kanota et al., U.S. Patent No. 5,991,500 and in view of Bersson, U.S. Patent No. 6,081,897 for reasons stated on pages 8-12 of the final Office Action. Likewise, dependent claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Katz et al., U.S. Patent No. 5,926,624, Kanota et al., U.S. Patent No. 5,991,500 and Bersson, U.S. Patent No. 6,081,897, as applied to claims 17, 18, 24 and 27, in further view of Fuchigami et al., U.S. Patent No. 5,960,398 for reasons stated on pages 12-14 of the Office Action. Since these rejections are predicated upon the correctness of the rejection of their respective parent claims, Applicants respectfully traverse these rejections primarily based on the same reasons discussed against the rejection of their respective parent claims.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. area attorney at (202) 216-9505 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. Please charge any shortage of fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account of Stein, McEwen & Bui, LLP, No. 503333, and credit any excess fees to said deposit account.

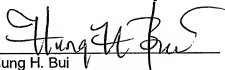
Respectfully submitted,

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